



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,360	12/28/1999	SOON-JIN KIM	678-427-(P89	9893
7590	03/24/2006		EXAMINER	
PAUL J FARRELL ESQ DILWORTH AND BARRESE 333 EARLE OVINGTON BOULEVARD UNIONDALE, NY 11553			NGUYEN, TU X	
			ART UNIT	PAPER NUMBER
			2618	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/473,360	KIM, SOON-JIN
	Examiner Tu X Nguyen	Art Unit 2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 February 2006.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

Applicant's Appeal brief of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The Examiner apologized for the improper rejection. However, upon further consideration, a new ground(s) of rejection is made as the following indications.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter "non-converted character data" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson et al. (US Patent 6,385,585).

As to claim 1, Jonsson et al. disclose a method for transmitting a character message in a mobile communication terminal while maintaining a conversation by telephone (see col.10 lines 32-39), the examiner interprets "during an ongoing conversation" reads on "while maintaining conversation", comprising the steps of:

Setting the mobile communication terminal to a character message-transmitting/receiving mode while in a state in which a speech path has been established between the mobile communication terminal and a mobile communication terminal of a party other than the user (see col.3 lines 46-67); and

inputting a character message while in the character message-transmitting/receive mode, processing the written character message and transmitting the written character message including non-converted character data to the communication terminal of the other party via the established speech path in the character message-transmitting/receiving mode (see col.10 lines 39-44, a short message corresponds to "non-converted character data").

As to claim 2, Jonsson et al. disclose returning the mobile communication terminal of the user to a phone mode after the transmission of the character message to the mobile communication terminal of the other party (see col.11 lines 39-44).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Makela et al. (US Patent 6,301,338).

As to claim 3, Jonsson et al. fail to disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state.

Makela et al. disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state (see col.5 lines 44-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Makela et al. in order to provide user conveniently to transmit pre-stored messages to other party.

6. Claims 4-5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Svensson (US Patent 5,687,216).

As to claim 4, Jonsson et al. fail to disclose receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message.

Svensson discloses receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message (see col.6 lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Svensson in order to provide another message is received before the users reads the current message (as suggested by Svensson, see col.6 lines 1-7).

As to claim 5, the modified Jonsson et al. disclose all limitations as to claims 1 and 4 above.

### Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed Tu Nguyen whose telephone number is 571-272-7883. The examiner can normally be reached on Monday through Friday from 6:30AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
March 16, 2006

  
EDWARD F. URBAN  
SUPPLYING PATENT EXAMINER  
TECHNOLOGY CENTER 2300